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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323
24628	7590	04/07/2006	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/777,098

Applicant(s)

BERNSTEIN, ROBERT

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 1/11/06.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 2-4, 10-12 are inconsistent with the embodiment(s) of the base claim. The base claim states that customer data is released to the vendor in summary form which appears to be consistent with the specification page 5 where the released information is contact information (such as an email address). In these embodiments, the promotional materials are delivered to the customer through channels other than the POS, yet claims 2-4 and 10-12 appear to describe only the embodiment where promotional delivery is accomplished via the POS. Applicant's claims conflict with the specification and are confusing.
- Claims 9, 17 are apparatus claims, yet they are presented with limitations that appear to be method steps rather than structure, rendering the claim scope unclear. Applicant should clearly further limit the apparatus with structure (i.e.

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elements of the apparatus which are *programmed or configured* to carry out the recited functionality).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-5, 8-13, 16-19, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Oytac (2003/0018613). This published application enjoys the earlier benefit of and incorporates by reference 60/221774 (filed 7/31/00). This Office Action shall refer to the disclosure of 60/221774 by page number rather than the 2003/0018613 document.**

6. Regarding claims 1, 9, 17, Oytac teaches information providers (banks, credit card processors) that compile detailed user profiles concerning the user's purchasing histories. This is taken to provide a third party database. Information users (vendors) define desired user profiles who are to receive targeted promotional materials. Customers who match the defined profiles are selected as the recipients of the defined promotional materials [pg 1 of 60/221774]. While no particular step of "requesting" by customers is claimed, customers who make purchases with such credit cards are taken

to implicitly give their permission for collection of such purchase data which forms the customer profiles. Oytac teaches that an interface is provided for a vendor to define the desired profile characteristics and the promotional materials to be delivered [pg 2, fig 1 of 60/221774]. The system of Oytac performs a matching of stored profiles and defined desired profiles and is taken to meet the comparator/searching limitations. Oytac states that the vendors may view customer information stored in its 3<sup>rd</sup> party database, but only in aggregate (or summary) form [pg 1]. Oytac's system then can automatically deliver the promotional materials.

7. Regarding claims 2-4, 10-12, 18, 19, Oytac teaches that a POS system can provide trigger-driven promotions printed on a receipt [pg 4]. Oytac teaches that the promotions can include coupons [pg 2].

8. Regarding claims 5, 13, Oytac teaches a promotional delivery channel using email [pg 4].

9. Regarding claims 6, 14, 20, the broad limitation that the promotional materials include "indicia of authenticity" without any corresponding steps or feature to verify the authenticity of such indicia can be met by any indicia printed on the promotion of Oytac. The printed materials of Oytac are taken to inherently include at least some "indicia".

10. Regarding claims 8, 16, 22, Oytac teaches an example where promotions are based upon types of purchases [pg 5]. Oytac also teaches the use of product categories [pg 22].

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 7, 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac in view of Katz (US20020077901). Page 10 of Katz's 60/256324 has been included to demonstrate support for the important feature to 12/19/2000.**

13. Regarding claims 7, 15, 21, Oytac teaches targeting to users based upon location [pg 5], but not necessarily based upon purchase location. Katz teaches custom promotions offered to users that includes various user profile parameters including locations where purchases were made [¶ 40].

***Response to Arguments***

14. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc